

## **REMARKS**

The paper is in response to the Office Action mailed February 10, 2009 (“the Office Action”). No claims are amended, added, or canceled in this paper. Claims 1-15 and 17-21 remain pending in the application. Applicants respectfully request reconsideration of the application in view of the following remarks. For Examiner’s convenience and reference, Applicants present remarks in the order that the Office Action raises the corresponding issues.

In connection with the prosecution of this case and any related cases, Applicants have, and/or may, discuss various aspects of the disclosure of the cited references as those references are then understood by the Applicants. Because such discussion could reflect an incomplete or incorrect understanding of one or more of the references, the position of the Applicants with respect to a reference is not necessarily fixed or irrevocable. Applicants thus hereby reserve the right, both during and after prosecution of this case, to modify the views expressed with regard to any reference.

Please note that Applicants do not intend the following remarks to be an exhaustive enumeration of the distinctions between any cited references and the claims. Rather, Applicants present the distinctions below solely by way of example to illustrate some of the differences between the claims and the cited references. Finally, Applicants request that Examiner carefully review any references discussed below to ensure that Applicants’ understanding and discussion of any reference is consistent with Examiner’s understanding.

Unless otherwise explicitly stated, the term “Applicants” is used herein generically and may refer to a single inventor, a set of inventors, an appropriate assignee, or any other entity or person with authority to prosecute this application.

## **Finality Precluded**

If the next office action rejects any of claims 1-15 and 17-21 using a new ground of rejection, the next office action must be nonfinal because the current Office Action fails to establish a *prima facie* case that claims 1-15 and 17-21 are obvious over the cited references. MPEP §706.07(a) states that “second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by

applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." In the present case, if the next office action rejects any of claims 1-15 and 17-21 using a new ground of rejection, such a rejection would not be necessitated by this response because none of the rejected claims was amended in order to distinguish over the cited references, as explained in the following remarks. Moreover, this new rejection would not have been based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) because no information disclosure was filed and/or none was filed with the fee. Accordingly, under MPEP §706.07(a), the next Office Action must be non-final if it rejects any of claims 1-15 and 17-21 using a new ground of rejection.

### **Rejection under 35 U.S.C §103(a)**

The Office Action rejects claim 1 under 35 U.S.C §103(a) over *Sharon* (U.S. Patent No. 6,205,122) in view of *Paiam* (U.S. Patent Publication No. 2001/0040681) and in further view of *Astle* (U.S. Patent No. 5,365,552). The office action also rejects claim 2 under 35 U.S.C §103(a) over *Sharon* in view of *Paiam* in view of *Astle* in further view of *Ikeda* (U.S. Patent Publication No. 2003/0063571). The Office Action also rejects claims 3-6 under 35 U.S.C §103(a) over *Sharon* in view of *Paiam* in view of *Astle* in view of *Ikeda* and in further view of *Warren* (U.S. Patent Publication No. 2004/0081186). The Office Action also rejects claims 7 and 10-13 under 35 U.S.C §103(a) over *Ikeda* in view of *Leary* (U.S. Patent No. 2003/0153085) and further in view of *Warren*. The Office Action also rejects claims 8 and 9 under 35 U.S.C §103(a) over *Ikeda* in view of *Leary* and further in view of *Warren* and further in view of *Sharon*. The Office Action also rejects claim 14 under 35 U.S.C §103(a) over *Ikeda* in view of *Leary* in view of *Warren* and further in view of *Pulsipher* (U.S. Patent No. 5,948,055). The Office Action also rejects claim 15 under 35 U.S.C §103(a) over *Sharon* in view of *Smorgrav* (U.S. Patent No. 6,615,261). The Office Action also rejects claims 18-21 under 35 U.S.C §103(a) over *Sharon* in view of *Smorgrav* and further in view of *Warren*. Under 35 U.S.C §103(a), "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

According to MPEP §2142, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” Finally, MPEP 2141.III notes that:

“The key to supporting any rejection under 35 U.S.C. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious***. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “***[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.***” KSR, 550 U.S. at \_\_\_, 82 USPQ2d at 1396.” (emphasis added)

Applicants respectfully traverse the rejections of claim 1-15 and 17-21 for at least the reason that the Office Action fails to present a *prima facie* case that claims 1-15 and 17-21 are obvious. Under the guidelines in the MPEP, Examiner must establish that the references teach or suggest each and every claim element or explain “why the difference(s) between the prior art and the claimed invention would have been obvious.” The Office Action does neither.

a. **claims 1-6**

Claim 1 recites, among other things, “interleaving the channelized data into a unitary data stream in chronological order.” (*Emphasis added*). In the Office Action, the Examiner concedes that “Sharon did not disclose interleaving the channelized data into a unitary data stream in chronological order.” *Office Action, page 2* (*emphasis added*). However, the Examiner has asserted that “Paiam discloses interleaving the channelized data into a unitary data stream in chronological order.” *Id.* (*emphasis added*). For support for this assertion, the Examiner has cited paragraph [0068] of *Paiam*, which teaches:

[0068] The operation of the circuit of FIG. 9 is similar to the operation of the de-interleaver/interleaver shown in FIG. 2. In FIG. 9 an input signal  $a_{in}$  is launched into port 1 and is divided equally into two de-interleaved signals on waveguides 912 and 914 at ports 3 and 4 respectively of the coupler 910. The transmission signal at and reflection signal  $a$ , transmitted through and reflected from the etalon between the couplers 910 and 920 are input into port 1 and 2 of the MMI coupler 930 and are provided as two de-interleaved output signals. Of course, each de-interleaved output stream can be provided to yet another similar de-interleaving

circuit for further de-interleaving the channelized signals. For example, at a first stage such as the one described in reference to FIG. 9, channels 1, 3, 5, 7, ... are output on  $a_{out1}$  and channels 2, 4, 6, 8, ... are output on  $a_{out1}$ . Notwithstanding, channels 1, 3, 5, 7, 9, can be fed to a similar circuit to circuit 900 wherein the etalon has a greater FSR so that two other data streams 1, 5, 9 and, 3, 7, 11 can further be demultiplexed.

While Applicants concede that this paragraph of *Paiam* deals generally with the concept of de-interleaving channelized signals, Applicants are unable to determine how this portion of *Paiam* teaches or suggests "interleaving the channelized data into a unitary data stream in chronological order" as nothing in this portion of *Paiam* appears to teach or suggest a "chronological order" as recited in claim 1.

Because the Office Action neither shows that the references teach or suggest the above-cited limitation of claim 1 nor explains why the differences between the prior art and the claimed invention would have been obvious to a person of skill in the art, the Office Action fails to present a *prima facie* case that claim 1 is obvious and the rejection is thus improper. Applicants therefore respectfully request that Examiner withdraw the rejection under 35 U.S.C. §103(a) of claim 1, and the rejections of claims 2-6 which depend therefrom.

**b. claims 7-14**

Claim 7 recites:

A method for determining network topology during a network analysis process, comprising:

positioning a *plurality* of network analyzers in communication with the network;

capturing trace data from a first and second channel on each of the analyzers;

determining a first topology corresponding to the first channel of each said analyzer;

determining a second topology corresponding to the second channel of each said analyzer;

combining the first and second topologies from each of the analyzers; and

deleting duplicate topology entries from the combined topology to generate the network topology.

(*Emphasis added*). In the Office Action, the Examiner concedes that "Ikeda did not disclose positioning a plurality of network analyzers in communication with the network." *Office Action*, page 7. However, the Examiner has asserted that:

Referring to claim 7 Ikeda disclose a method for determining network topology during a network analysis process; capturing trace data from a first and second channel on each of the analyzers (Abstract); determining a first topology corresponding to the first channel of each said analyzer (Fig 21 A); determining a second topology corresponding to the second channel of each said analyzer (Fig .21 A and Fig 21 B.), combining the first and second topologies from each of the analyzers (Fig. 21 A [0155]).

*Office Action*, page 7 (*emphasis added*). Therefore, it appears that the Examiner has asserted that *Ikeda discloses*:

- 1) capturing trace data from a plurality of network analyzers,
- 2) determining first and second topologies of each of the plurality of network analyzers, and
- 3) combining the first and second topologies of each of the plurality of network analyzers,

while the Examiner has simultaneously conceded that *Ikeda fails* to disclose a plurality of network analyzers in the first place. Further, the Examiner has made no attempt to resolve these contradictory assertions using "articulated reasoning with some rational underpinning" as required by *KSR*. For example, the Examiner has not articulated how *Ikeda* can possibly teach capturing trace data from a plurality of network analyzers while conceding that *Ikeda* does not disclose "positioning a plurality of network analyzers in communication with the network." Further, the Examiner has not articulated how *Ikeda* can possibly teach determining topologies and combining topologies of a plurality of network analyzers while conceding that *Ikeda* does not disclose "positioning a plurality of network analyzers in communication with the network."

Because the Office Action neither shows that the references teach or suggest each and every claim element of claim 7 nor explains why the differences between the prior art and the claimed invention would have been obvious to a person of skill in the art, the Office Action fails

to present a *prima facie* case that claim 7 is obvious and the rejection is thus improper. Applicants therefore respectfully request that Examiner withdraw the rejection under 35 U.S.C. §103(a) of claim 7, and the rejections of claims 8-14 which depend therefrom.

**c. claims 15 and 17-21**

In the present Office Action, the Examiner repeated verbatim the rejection of claim 15 set forth in the previous Office Action mailed September 4, 2008 without taking note of, much less responding to, the following remarks set forth on page 10 of Applicants' paper dated October 17, 2008 and on page 10 of Applicants' paper dated January 11, 2008:

Claim 15, as amended, recites, among other things: "capturing a left channel and a right channel data trace from each of the at least one analyzers; combining the left and right channel data traces into a unitary data stream; [and] extrapolating network device presence indicators from the unitary data stream." According to the Examiner, the Abstract of *Sharon* discloses "capturing a left channel and a right channel data trace...[and] extrapolating network device presence indicators from the left and right channel data." *See Office Action*, p. 12. Applicants respectfully disagree.

The Abstract of *Sharon* generally describes automatically detecting a physical network topology using information from a variety of sources such as computers, agents, and bridging tables. The Abstract does not discuss what if any specific channel data traces are captured, much less whether any network device presence indicators are extrapolated from the data traces. Thus, the Abstract has no relationship to the specific claim limitations: "capturing a left channel and a right channel data trace from each of the at least one analyzers...[and] extrapolating network device presence indicators...." Should the Examiner maintain the same ground of rejection, Applicants respectfully request a more detailed explanation of how *Sharon* relates to the aforementioned claim limitations. *See 37 CFR 1.104.*

In addition, in repeating verbatim the rejection of claim 15 in the present Office Action, the Examiner failed to take note of, much less respond to, the following remarks set forth on page 11 of Applicants' paper dated October 17, 2008:

Moreover, in rejecting claim 15, the Examiner conceded, "Sharon does not disclose combining the left and right channel data traces into a unitary data stream." *See Office Action*, p. 12. The Examiner asserted, however, that "Smorgrav discloses combining the left and right channel data traces into a unitary data stream (Col. 6 lines 21-28...)." *See id.* Applicants respectfully disagree.

*Smorgrav* describes performance analysis of data networks, including collection of performance data and using it “to detect problems that arise during network operation, or to detect trends in the network....” *See id.* col. 1, lines 10-25. For example, *Smorgrav* describes a process in which a “single data stream” is calculated from “one or more streams of samples for a time interval” and that “[t]he result of the process can be used to generate human readable reports used for network planning or troubleshooting, right-sizing of the network capacity, Service Level Agreement (SLA) analysis and monitoring, traffic-based routing and even automatic correction of error conditions in the network.” *See col.* 6, lines 21-37. Therefore, *Smorgrav* contemplates using the results for various purposes but does not consider the results pertinent to “extrapolating network device presence indicators,” as claimed. Consequently, the Examiner’s apparent assumption that the results could be used for such purposes in the proposed combination with *Sharon* is mere speculation. “[R]ejections on obviousness cannot be sustained by mere conclusory statements.” *See MPEP* § 2141.III (citing KSR, 550 U.S. at \_\_, 82 USPQ2d 1385, 1396). Therefore, should the Examiner maintain the same ground of rejection, clarification is respectfully requested as to how *Sharon* would extrapolate “network device presence indicators” from the single data stream produced by *Smorgrav*, which is used to generate human readable reports.”

The failure of the Examiner to address Applicants’ prior arguments is contrary to established examination guidelines. Particularly, Applicants note that “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, *take note of the applicant’s argument and answer the substance of it.*” *M.P.E.P.* § 707.07(f) (emphasis added).

In light of the foregoing, Applicants respectfully submit that the Examiner has not established a *prima facie* case that claim 15 is obvious and the rejection is thus improper. Applicants therefore respectfully request that Examiner withdraw the rejection under 35 U.S.C. §103(a) of claim 15, and the rejections of claims 17-21 which depend therefrom.

### **Charge Authorization**

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

**CONCLUSION**

In view of the foregoing, Applicants submit that the pending claims are allowable. In the event that Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview or overcome by an Examiner's Amendment, Examiner is requested to contact the undersigned attorney.

Dated this 10th day of June, 2009.

Respectfully submitted,

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